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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,810	04/15/2004	Fernando Incertis Carro	FR920030003US1	1564
30449 7590 12/13/2010 SCHMEISER, OLSEN & WATTS 22 CENTURY HILL DRIVE SUITE 302 LATHAM, NY 12110				
EXAMINER				
HUYNH, BA				
ART UNIT		PAPER NUMBER		
2179				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/826,810

Applicant(s)

CARRO ET AL.

Examiner

Ba Huynh

Art Unit

2179

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-18, 20-23 and 25-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-18, 20-23, 25-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ ~~Notice of Informal Patent Application~~
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 29 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 29 directs to software per se ("A computer program"). Software per se is non-statutory subject matter.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225

USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10, 12-18, 20-23, 25-29 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,940,491 in view of US patent application publication 2004/0021648 (Blume). Presenting the retrieved data visually or audibly to visual impaired person would have been obvious in view of Blume (see par 0051).

Claim Rejections - 35 USC § 103

Claims 1-10, 12-18, 20-23, 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent application publication 2002/0152236 (Incertis-Carro, hereinafter Carro), in view of US patent application publication 2004/0021648 (Blume), further in view of US patent 6,115,482 (Sears).

In regard to Independent claims 1, 10, 26, 29, Carro teaches a computer implemented method and corresponding apparatus for use in a user system, for accessing information related to a physical document, said method comprising the steps of:

- Identifying a physical document (0097, 0109, 0135, 0173, 0175),
- Identifying and locating an electronic copy of said identified document (0122, 0124, 0128, 0173, 0175).
- Identifying one or a plurality of pages of said physical document and identifying a part of the identified physical document using the position of points on said identified pages (0109, 0110),
- retrieving from the electronic copy of the physical document, data related to the selected part of the document (0110, 0111, 0178),

Carro is silent regarding presenting the retrieved data to visual impaired and blind individual. In the same field of the invention, Blume teaches a method for interacting with a physical document using a touch foil overlaying the physical document (Blume's 0025, 0029). Data associated with selected part of the physical document is retrieved and presented to visual impaired person (0007, 0051. Per Blume, "(the system) ... and provide speaking books for the visual impaired"). It would have been obvious to one of skill in the art, at the time the invention was made, to combine Blume's teaching of audibly presenting the retrieved data to visual impaired person. Motivation of the combining is to enable visual impaired person to audibly access the information. Although the retrieved data is presented as audio, video, or both (0025, 0029, i.e., the

system is capable to present the retrieved data visually to a visually impaired person or orally to a blind person), Blume fails to clearly address presenting the retrieved data visually to a visually impaired person. In the same field of the invention, Sears teaches presenting the retrieved data such that to enable the visually impaired person to see said retrieved data, and orally to enable blind person to hear the data (abstract). It would have been obvious to one of skill in the art, at the time the invention was made, to combine Sears' teaching of providing the retrieved data visually and orally to visual impaired and blind person to Carro. Motivation of the combining is for allowing visual impaired and blind person to access the data.

With respect to dependent claims 2, 27, Carro teaches the method wherein identifying one or a plurality of pages of said physical document and identifying a part of the identified physical document using the position of points on said identified pages further comprises pressing said points on a touch foil successively placed and aligned over or under said identified pages (0110, 0111, 0128). Carro teaches that the system is connected to a communication network (0111).

With respect to dependent claim 3, Carro teaches the method wherein said physical document and pages in said physical document are selected by a user (0097, 0109, 0122, 0191, 0196, 0205).

With respect to dependent claim 4, Carro teaches the method wherein a point on a touch

foil is pressed with a fingertip (0111).

With respect to dependent claim 5, Carro teaches selecting an illuminated element of the page, however fails to clearly teach selecting a portion of a page which portion comprises a start point and an end point. In the same field of invention, Blume teaches a drag selection comprising determining the position of a first point pressed on the touch foil placed and aligned over or under the identified first page, said first point corresponding to the start point of a part selected in said identified document, if start point and end point of the selected part are on a same page: determining the position of a second point pressed on the touch foil placed and aligned over or under the identified page of said document, said second point corresponding to the end point of said selected part (0029, in a drag operation, the user selects a start point and an end point using the pen. The start and end point can be in the same page). It would have been obvious to one of skill in the art, at the time the invention was made, to combine Blume teaching of drag selection to Carro. Motivation of the combining is for allowing to select a portion of the document. Blume further teaches page turning operation (0033, 0036, 0040, 0048). It appears that in the drag operation together with the page turning, the user can select a bridging portion of a page which has the start point on a first page and the end point on the next page. Even if it is not, it would have been obvious to one of skill in the art to implement such selection which has the start point on a first page and the end point on the next page. Motivation of the implementation is for selecting bridging portion of a page.

With respect to dependent claims 6, 7: Sears teaches that user selected text is extracted and converted to speech (Sears' 6:13-14). It would have been obvious to one of skill in the art, at the time the invention was made to combine Sears' teaching to Carro for converting selected text to speech. Motivation of the combining is for real time text to speech conversion (vs. pre-stored converted audio representation).

As for claims 8, 9: Per Sears, selected portion of text can be magnified to help visual impaired individual (10:47-49, abstract).

As for claim 12: User's reading view can be enhanced in any preferred way (Blume's 0051, 0052; Sears' 27:9-21, 28:13-24).

As for claims 13, 28: Document identifier of the physical document can be read by a barcode reader (Carro's 0191). It would have been obvious to one of skill in the art that the barcode is located at a predefined position on the book for easy access.

As for claim 14: Page identifier of the pages of the physical document can be read by a barcode reader (Carro's 0109, 0196. Sears' 17:1-11). It would have been obvious to one of skill in the art that the barcode is located at a predefined position on the book for easy access.

As for claim 15: In view of the combined Carro&Blume&Sears, retrieved data corresponding to selected part of the printed document is audibly presented to blind individual. The data comprises information and/or services associated with the selected part (Carro's 0110, 0111, 0211; Blume's 0051; Sears' 15:35-67).

As for claim 16: Information associated with the selected part of the printed document can be description of graphical data related to the selected part (Blume's 0025, 0029; Sears' abstract, 20:3-24.).

As for claim 17: In light of the combining, Carro&Blume&Sears the system would comprises a database of electronic copies of scanned printed documents, wherein the electronic copy corresponds to the printed document is retrieved and orally presented to the blind person (Blume's 0025, 0029).

As for claim 18: the information associated with the physical document includes speech instruction (Blume's 0051, 0052).

As for claim 20: The system is connected to a communication network comprising a plurality of servers. The electronic copy is located in one of the servers (Carro's 0035, 0041, 0110; Blume's 0042, 0043, 0046).

As for claims 21, 23: The electronic copy is located on the user system (Carro's 0153, 0175; Blume's 0042, 0043).

As for claim 22: The system is connected to a communication network comprising a plurality of servers. The electronic copy is located in one of the servers (Carro's 0035, 0041, 0110; Blume's 0042, 0043, 0046). The system transmits to a server a document identification code and a page code to identify the electronic copy and a page of the electronic copy of the physical document (Carro's 0109, 0138, 0171, 0191; Blume's 0029; Sears' 17:6-9).

As for claim 25: In light of both Blume and Sears' teaching of providing access to visual impaired and blind person as set forth above, also further in light of Sears' teaching of reading Braille text (27:10-13), it would have been obvious to one of skill in the art, at the time the invention was made, to implement the providing of Braille indications in the physical document to enable visual impaired and blind person to interact with the physical document.

A reference to specific paragraphs, columns, pages, or figures in a cited prior art reference is not limited to preferred embodiments or any specific examples. It is well settled that a prior art reference, in its entirety, must be considered for all that it expressly teaches and fairly suggests to one having ordinary skill in the art. Stated differently, a prior art disclosure reading on a limitation of Applicant's claim cannot be ignored on the ground that other embodiments disclosed were instead cited. Therefore, the Examiner's citation to a specific portion of a single prior art reference is not intended to exclusively dictate, but rather, to demonstrate an exemplary disclosure commensurate with the specific limitations being addressed. *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)). *In re: Upsher-Smith Labs. v. Pamlab, LLC*, 412 F.3d 1319, 1323, 75 USPQ2d 1213, 1215 (Fed. Cir. 2005); *In re Fritch*, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1782 (Fed. Cir. 1992); *Merck & Co. v. Biocraft Labs., Inc.*, 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989); *In re Fracalossi*, 681 F.2d 792, 794 n.1, 215 USPQ 569, 570 n.1 (CCPA 1982); *In re Lamberti*, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976); *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ba Huynh whose telephone number is (571) 272-4138. The examiner can normally be reached on Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on 571-272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ba Huynh/
Primary Examiner, Art Unit 2179